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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/549,480	09/15/2005	Masahiro Yamakawa	4670-0110PUS1	8164
2292 7590 08/01/2007 BIRCH STEWART KOLASCH & BIRCH PO BOX 747 FALLS CHURCH, VA 22040-0747			EXAMINER REDDY, KARUNA P	
			ART UNIT 1713	PAPER NUMBER
			NOTIFICATION DATE 08/01/2007	DELIVERY MODE ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

mailroom@bskb.com

<b>Office Action Summary</b>	<b>Application No.</b> 10/549,480	<b>Applicant(s)</b> YAMAKAWA ET AL.	
	<b>Examiner</b> Karuna P. Reddy	<b>Art Unit</b> 1713	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 18 June 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. This office action is in response to amendment filed on June 18, 2007. Claims 1-11 are currently pending.

#### ***Claim Rejections - 35 USC § 102/103***

2. The statutory statements from paragraph 1-3 of previous office action dated Jan 18, 2007 are incorporated herein by reference.
3. Claims 1-4 and 6-11 remain rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Yamakawa et al (US 6,656,633 B2).

The rejection is adequately set forth in paragraph 4 of previous office action dated Jan 18, 2007 and is incorporated herein by reference.

#### ***Claim Rejections - 35 USC § 103***

4. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Yamakawa et al (US 6,656,633 B2) as applied to claims 1-4 and 6-11 above, and further in view of Kasuke (JP 08-107047).

The rejection is adequately set forth in paragraph 5 of previous office action dated Jan 18, 2007 and is incorporated herein by reference.

#### ***Response to Arguments***

5. Applicant's arguments filed on Jan 18, 2007 in response to rejection of claim 1-4 and 6-11 under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Yamakawa et al (US 6,656,633 B2) have been fully considered but they are not persuasive.

In response to applicant's argument that binder of Yamakawa et al is used for an electrode for lithium ion secondary battery as opposed to an electrode for electric double layer capacitor of present invention, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

In response to applicant's arguments, the recitation "for an electrode for an electric double layer capacitor" has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

As to the experimental report intended to show unexpected results, it is not presented in the form of an affidavit or declaration.

Even if it was presented in the form of an affidavit or declaration, applicants arguments on data pertaining to superior "swelling ratio to electrolytic solution", "peel strength", "industrial discharge capacity" and "discharge capacity after 100 hours at 70<sup>0</sup>C" is not convincing for the following reasons: The components in the invention example no. 1 and the comparative runs no. 2 and 3 include more than one variable to ascertain the advantages of the invention. The trials are not back-to-back consecutive trails because the inventive run includes as monomer components - n-butyl acrylate and methacrylonitrile while the comparative runs include a combination of n-butyl acrylate, methacrylonitrile and acrylic acid or a combination of 2-ethylhexyl acrylate, methacrylonitrile and acrylic acid. Back-to-back runs require that the monomer components remain the same in all trials. Therefore, it is not clear if the superior "swelling ratio to electrolytic solution", "peel strength", "industrial discharge capacity" and "discharge capacity after 100 hours at 70<sup>0</sup>C" cited in the experimental report is to be attributed to the difference in the monomer components or to the multifunctional component (C) i.e. diethylene glycol dimethacrylate.

Additionally, the working examples in table 1 of the instant specification disclose only two multi-functional ethylenically unsaturated carboxylic acid esters i.e. diethylene glycol dimethacrylate and tetraethylene glycol dimethacrylate. However, instant claim 1 includes a broad genus of multi-functional ethylenically unsaturated carboxylic acid ester that does not appear to be commensurate in scope with the experimental data. Even if the trials are back-to-back consecutive

trials, data is not commensurate in scope with the claims. Further, it is also not evident if the difference in superior "swelling ratio to electrolytic solution", "peel strength", "industrial discharge capacity" and "discharge capacity after 100 hours at 70°C" for inventive and comparative trials in table 1 of the instant specification is substantial to demonstrate unexpected results.

For reasons discussed above, the rejections over Yamakawa et al are maintained.

6. Applicant's arguments filed on Jan 18, 2007 in response to rejection of claim 5 under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Yamakawa et al (US 6,656,633 B2) have been fully considered but they are not persuasive.

The reasons for sustaining rejection under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Yamakawa et al (US 6,656,633 B2) is provided in paragraph 5.

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory

action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Karuna P. Reddy whose telephone number is (571) 272-6566.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu can be reached on (571) 272-1114. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service

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Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Karuna P Reddy  
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